

REMARKS

Claims 4-13, 15-40 and 52 are pending in this application.

Claims 1-3, 14 and 41-51 have been canceled.

Independent claims 42-51 were previously added in the August 7, 2003 supplemental amendment as essential duplicates of independent claims 4-8 and 20-24, respectively, except that claims 42-51 differed in the use of transitional phrases ("comprises" versus "consisting of").

In view of the fact that Applicants intend the substrate layer and the skin layer to include non-listed components, Applicants have amended independent claims 4-8 and 20-24 to include the open ended transitional phrase "comprising" and have canceled claims 42-51.

New claim 52 recites that the ethylenic thermoplastic elastomer (A) has no crosslinking prior to dynamic heat treatment. This means that neither component (a-1) nor (a-2) are crosslinked prior to dynamic heat treatment. Support for this description can be found in the first full paragraph on page 30 of the present specification, which states that:

"The ethylenic thermoplastic elastomer (A) to be used according to the present invention is superior in the rubbery elasticity even without being subjected to cross linking (vulcanization) using a cross-linking agent and cross-linking assistant. ... It does require no use of cross-linking agent ..." (Emphasis added).

It is Applicants' position that this disclosure at page 30 sufficiently describes that neither the composition of (A) nor any individual component of (A) is crosslinked prior to dynamic heat treatment.

No new matter has been added by way of the above-amendment.

Interview

Applicants note with appreciation that the Examiner conducted a personal interview with Applicants' representative, Garth M. Dahlen, Ph.D., Esq. (#43,575) on September 8, 2005 to discuss the outstanding issues.

On the Interview Summary Form, the Examiner states:

The 112 claim rejections have been withdrawn because the phrase "consisting of" in combination the phrase "optionally" is clear on its face as argued by Applicant's representative. The proposed amendment "the copolymer (a-2) is not crosslinked" renders the instant claims unobvious over the prior art because the crosslinked plastic elastomer (A-3) is a required component of the Yorita invention. Applicant will provide support for the negative limitations in the specification. Although it is recognized that the specification has shown that the foam core of the olefinic thermoplastic elastomer exhibits superior properties over the solid core made of the same material. However, it is suggested that the declaration will be submitted to show that the solid core described in the specification is the same as the solid core disclosed in the EP '617.

Further details of the interview are discussed below.

[I] Issues Under 35 U.S.C. 112, 2nd paragraph

Claims 20, 27-35, 37 and 47 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite. Applicants respectfully traverse the rejection.

In the outstanding Office Action, the Examiner objects to claim 20 for reciting both the term "consisting of" and the term "optionally" with respect to the description of the skin layer.

During the interview, the Examiner agreed with Dr. Dahlen that claim 20 which recites both the term "consisting of" and the term "optionally" is not indefinite and satisfies the requirements of 35 U.S.C 112, 2nd paragraph. However, since the interview, Applicants have decided to amend claim 20 to recite both the term "comprising " and the term "optionally" with respect to the description of the skin layer. Applicants respectfully submit that this combination of terms is not indefinite and satisfies the requirements of 35 U.S.C 112, 2nd paragraph. As such, withdrawal of the rejection is respectfully requested.

[III] Issues under 35 U.S.C. 103

Claims 4-13, 15-40 and 42-51 are rejected under 35 U.S.C. 103(a) as being unpatentable over EP 974 617 (EP'617) in view of EP 976 782 (since the Examiner is relying on US 6,306,666, we hereinafter refer to this reference as US '666). Applicants respectfully traverse the rejection.

[II-A] Unexpected Results:

During the interview, Dr. Dahlen argued that the present specification describes experiments showing unexpected results over the base reference of EP '617. However, the Examiner remained unclear as to whether Applicants have repeated the closest operative embodiment of EP '617.

The Examiner has taken the position that EP '617 recites the use of a laminate having a skin layer with a solid core made of an olefin thermoplastic resin. In the present specification, the inventive laminate which comprises a skin layer and a foamed core with a comparative

example wherein the laminate has a skin layer and a solid core made of an olefinic thermoplastic resin (J-1). See page 108, first full paragraph and the paragraph bridging pages 98-99. The Examiner expressed concern that the olefinic thermoplastic resin (J-1) used in the comparative examples in the present specification is not the same olefin thermoplastic resin used in EP '617.

First, the Examiner will note that EP '617 only generically refers to the use of an olefin thermoplastic resin as a material for the core, but EP '617 does **not**: 1) actually prepare any example containing a laminate of a core (solid or foamed) with a skin layer; and 2) provide any details of the exact composition of the olefin thermoplastic resin for use in the core although it is clear that the olefin thermoplastic resin suggested by EP '617 for use in the core is a solid and not a foamed material.

In view of the fact that EP '617 does not even prepare an example containing a laminate of a core (solid or foamed) with a skin layer, Applicants submit that the examples in the present specification are closer to the claimed invention than the examples of EP '617, and as such are probative of patentability.

Second, Applicants enclose a Declaration by one of the coinventors, Mr. Kyoko KOBAYASHI. In the Declaration, Mr. Kobayashi describes experiments, which were originally described in the specification. As noted above, the Examiner agreed that these experiments showed unexpected results over the composition of EP '617 assuming that EP '617 made a laminate having a core of olefin thermoplastic resin and a skin layer. However, as described above, EP '617 does not actually prepare a laminate. Furthermore, Mr. Kobayashi is of the opinion that the actual solid core used in the comparative examples in the present specification

and Declaration are typical thermoplastic elastomers. Specifically, Mr. Kobayashi states:

"Furthermore, I was an inventor on EP '617. EP '617 simply describes the composition of the core as being made from a "thermoplastic elastomer" (see paragraph 0079). It is my opinion that the olefinic thermoplastic elastomer (T-1) used as the solid core for Comparative Example 3-1 and Comparative Example 3-4 is a typical thermoplastic elastomer used for the core described on paragraph 0079 of EP '617. Accordingly, the above-mentioned tests which include the olefinic thermoplastic elastomer (J-1) as the solid core for Comparative Example 3-1 and Comparative Example 3-4 are appropriate to show that a laminate comprising a solid core made of a thermoplastic elastomer as described in EP '617 is inferior to the inventive laminate comprising a foamed core." See the paragraph bridging pages 11-12 of the Declaration.

Accordingly, it is clear that the experiments in the present specification and Declaration are appropriate for comparison with EP '617 and as such, the present invention is not made obvious by EP '617, since neither EP'617 nor US '666 teach that using a foamed core would give such superior wear resistance and spongy hand touch to the laminate. In view of the fact that all claims require a foamed core and a skin layer in the laminate, withdrawal of the rejection over all the claims is respectfully suggested.

[II-B] Crosslinking of (a-2):

As noted in the Interview Summary form above, the Examiner agreed that amending the claims to recite that resin (a-2) is not crosslinked would distinguish from US '666. However, the Examiner was not clear that there was sufficient written description support for such an amendment.

First, Applicants have added this feature in new dependent claim 52 to ensure that the dependent claims are not construed to include this limitation based on the Examiner's comments in the Interview Summary form.

Second, the Examiner will note that there is sufficient written description support as described on page 22 above.

Accordingly, Applicants respectfully submit that new claim 52 is patentable over the cited references.

Conclusion

With the above remarks, Applicants believe that the claims, as they now stand, define patentable subject matter such that passage of the instant invention to allowance is warranted. A Notice to that effect is earnestly solicited.

Should there be any outstanding matters that need to be resolved in the present application, the Examiner is respectfully requested to contact **Garth M. Dahlen, Ph.D., Esq.**

Application No. 10/069,603
Amendment dated October 31, 2005
Reply to Office Action of June 30, 2005

Docket No.: 0992-0128P

(Reg. No. 43,575) at the telephone number of the undersigned below, to conduct an interview in an effort to expedite prosecution in connection with the present application.

Dated: October 31, 2005

Respectfully submitted,

By 

Marc S. Weiner
Registration No.: 32,181
BIRCH, STEWART, KOLASCH & BIRCH, LLP
8110 Gatehouse Road
Suite 100 East
P.O. Box 747
Falls Church, Virginia 22040-0747
(703) 205-8000
Attorney for Applicant

Attachment: Declaration under 37 C.F.R. 1.132 by Ms. Kyoko Kobayashi